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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,189	11/13/2003	Lilip Lau	PARCR 65988	9393

7590 12/14/2005

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EXAMINER
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GILBERT, SAMUEL G

ART UNIT	PAPER NUMBER
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3735

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

28

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/714,189	LAU ET AL	
	<b>Examiner</b>	<b>Art Unit</b>	
	Samuel G. Gilbert	3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 54-64 and 67-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 54-64 and 67-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/28/2005 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 67 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 67 contains the trademark/trade name Nitinol. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name

does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe nickel titanium metal and, accordingly, the identification/description is indefinite.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 54-64 and 67-76 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 54, 55, 57, 60-63, and 66-70 of copending Application No. 10/693,577. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences are obvious modifications in the scope of the claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 54-64 and 67-76 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 54, 55, 57, 58, and 60-62 of copending Application No. 10/314,696. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences are obvious modifications in the scope of the claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jayaraman (6,360,749) in view of Lau et al (6,517,570).

Claim 54 - Jayaraman teaches a medical device, figures 6B, 7B, 7C, 8A, 8B-12 and 14 for treating the heart including elastic bands adapted to extend circumferentially around an outer surface of the heart but does not teach the material including a plurality of hinge elements. Jayaraman does set forth that stent graft materials may be used

column 12 lines 19-29. Lau et al. sets forth a plurality of embodiments of stent graft material formed by a plurality of hinge elements, the embodiments of figures 3, 4, 5, 6, 8, 10, 11, 12, teach non-overlapping hinge elements. Lau et al sets forth that the hinged elements provide the advantage of being foldable to be delivered intraluminally, kink-resistant and self-expanding. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the stent graft material taught by Lau et al. to be used for the stent graft material set forth to provide the benefits as described above to the cardiac treatment device of Jayaraman. Lau et al. further teaches the use of metallic hinge elements with torsion bars provide the advantage of allowing the device to be formed from a flat sheet and having torsional balance by spreading the load when the material is folded into a small diameter, column 12 lines 1-8. The hinge elements of Lau et al are "self-sizing" and the cardiac device of Jayaraman is adapted to extend circumferentially around the heart.

Claim 55 – it is the examiner's position that the metallic material (stent graft material) of Lau et al. are identical to those claimed the harness would inherently generate a compressive force of not more than 10 mm Hg.

Claim 56 – it is the examiner's position that the metallic material (stent graft material) of Lau et al. are identical to those claimed the harness would inherently have a deformed shape and recovered shape as claimed.

Claims 57-59 and 62 – the device of Jayaraman teaches minimally invasive delivery of the harness, column 11, line 32.

Claim 60 – the compliance is an inherent feature of the hinge elements set forth in figures 1A-1E of Lau et al.

Claim 61 – Lau et al. teaches a plurality of bands, figures 8A, 8B, and 12. Further, because the hinge elements of Lau et al are identical to the claimed material the pressure as claimed is inherently provided by the combination.

Claim 63 – see column 12 line 3 of Jayaraman.

Claim 64 – it is the examiner's position that because the structure of the combination of Jayaraman and Lau et al is identical to the claimed device the function as claimed would be inherently present.

Claim 67 – Lau et al teaches the use of Nitinol, column 12 lines 31 and 32.

Claim 68 – Figures 8B and 12 show interconnected rows of hinge elements.

Claim 69 – see 54 and 62 above.

Claim 70 – it is the examiner's position that the metallic material(stent graft material) of Lau et al. are identical to those claimed the harness would inherently generate a compressive force of not more than 10 mm Hg.

Claim 71 – it is the examiner's position that the metallic material(stent graft material) of Lau et al. are identical to those claimed the harness would inherently have a deformed shape and recovered shape as claimed.

Claims 72 and 73 – the device of Jayaraman teaches minimally invasive delivery of the harness, column 11, line 32.

Claim 74 – Lau teaches a plurality of bands, figures 8A, 8B, and 12. Further, because the hinge elements of Lau et al are identical to the claimed material the pressure as claimed is inherently provided by the combination.

Claim 75 – see column 12 line 3 of Jayaraman.

Claim 76 – it is the examiner's position that because the structure of the combination of Jayaraman and Lau et al is identical to the claimed device the function as claimed would be inherently present.

### ***Response to Arguments***

Applicant's arguments with respect to claims 54-64 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Gilbert whose telephone number is 571-272-4725. The examiner can normally be reached on Monday-Friday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ali Imam can be reached on 571-272-4737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Samuel G. Gilbert', with a stylized flourish at the end.

Samuel G. Gilbert  
Primary Examiner  
Art Unit 3735

sgg